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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/721,363 11/22/00 SUUTARINEN

J 796.377USW1

EXAMINER

WM01/0913

ALTERA LAW GROUP
10749 BREN ROAD EAST
MINNEAPOLIS MN 55343

LEE, J

ART UNIT

PAPER NUMBER

2682

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/721,363

Applicant(s)

SUUTARINEN, JARI

Examiner

John J Lee

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 4.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Objections

1. Claim 11 is objected to because of the following informalities: the claim must be ended with a period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claims 2 – 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 – 11 recite the limitation "A" in starting word of every dependent claim should be changed "The". There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. **Claims 1 –11** are rejected under 35 U.S.C. 102(e) as being anticipated by Sanmugam (US Patent number 5978669).

Regarding **claim 1**, Sanmugam discloses that a method of trace activation in a mobile communications system, wherein a mobile station (MS) is in communication with the mobile communications network, whereby a trace report is generated for a mobile station (MS), characterized in that the method includes the following steps:

a communication from a mobile station (MS) is directed to a pre defined trace activation number (column 24, lines 62 – column 26, lines 33 and (Fig. 11, 12, 14) and

tracing is activated for the communicating mobile station (MS) (column 26, lines 34 – column 27, lines 64, abstract, and Fig. 12, 14).

Regarding **claim 2**, Sanmugam discloses all the limitation, as discussed in claim 1. Furthermore, Sanmugam further discloses that tracing is activated for the calling mobile station (MS) (column 25, lines 31 – column 28, lines 43), and

tracing is deactivated when the call is ended (column 26, lines 48 – column 27, lines 52).

Regarding **claim 3**, Sanmugam discloses that a message from the mobile station (MS) is directed to the predefined trace activation number (column 24, lines 62 – column 26, lines 33 and (Fig. 11, 12, 14) and

tracing is activated for the said mobile station (MS) (column 26, lines 34 – column 27, lines 64, abstract, and Fig. 12, 14).

Regarding **claim 4**, Sanmugam discloses that tracing is deactivated when a preset time period is elapsed (column 26, lines 34 – column 27, lines 52).

Regarding **claim 5**, Sanmugam discloses that tracing is deactivated when a second message from the mobile station (MS) is directed to the predefined trace activation number (Fig. 11, column 21, lines 57 – column 22, lines 54, and column 24, lines 62 – column 28, lines 43).

Regarding **claim 6**, Sanmugam discloses that defining at least one said trace activation number (Fig. 11 and column 24, lines 62 – column 28, lines 43).

Regarding **claim 7**, Sanmugam discloses that the call is made to a predefined trace activation number (Fig. 11 and column 24, lines 62 – column 28, lines 43).

Regarding **claim 8**, Sanmugam discloses that the call is forwarded to a predefined trace activation number (column 25, lines 43 – column 26, lines 64 and column 16, lines 26 – 57).

Regarding **claim 9**, Sanmugam discloses that tracing is activated and deactivated automatically at the switching center (MSC) (column 25, lines 43 – column 27, lines 19 and Fig. 12, 14).

Regarding **claim 10**, Sanmugam discloses all the limitation, as discussed in claim 1.

Regarding **claim 11**, Sanmugam discloses that equipment tracing is activated for the communicating mobile station (MS) (column 24, lines 62 – column 25, lines 16).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Scherer (US Patent number 6137870) discloses System for Providing Caller Information to Called Party Via Call Standard Data Field.

Alexander (US Patent number 6134593) discloses Automated Method for Electronic Software Distribution.

Taylor (US Patent number 5987325) discloses Multiple Smart Card Phone and Method.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(703) 306-5936**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are

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unsuccessful, the examiner's supervisor, **Vivian Chang**, can be reached on **(703) 308-6739**. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

J.L
September 8, 2001

John J Lee



VIVIAN CHANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600